



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,384	05/16/2001	Timothy D. Allen	47767-2	3415
24115 7590 03/06/2009 BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP 3800 EMBASSY PARKWAY SUITE 300 AKRON, OH 44333-8332				
EXAMINER				
NEWTON, JARED W				
ART UNIT		PAPER NUMBER		
3693				
NOTIFICATION DATE		DELIVERY MODE		
03/06/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKETAKRON@BDBLAW.COM
MMiller2@BDBLAW.COM
DHrina@BDBLAW.COM

Office Action Summary

Application No.

09/858,384

Applicant(s)

ALLEN ET AL.

Examiner

JARED W. NEWTON

Art Unit

3693

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No./Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This non-final rejection is in reply to the remarks filed December 16, 2008.

Claims 1-20 and 27-46 have been canceled. Claims 21-26 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 16, 2008 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention attempts to qualify as an eligible "process" under section 101. The Federal Circuit recently clarified the standards applicable in determining whether a claimed method constitutes a statutory "process" in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). Pursuant to the court's holding, the claimed method must (1) be tied to a particular machine or apparatus, or (2)

transform a particular article to a different state or thing. Claims 21-26 do not meet either of these standards.

With respect to the first prong, it is noted that claims 21-26 include "linking ... via the internet" (claim 21, lines 14-15). Although this recitation implies a computer or machine, it does not impose meaningful limits on the method claim's scope so as to satisfy the *Bilski* standard. With respect to the second prong, although the claims "revis[e] terms of [an] existing mortgage" (claim 21, lines 19-21), this revision merely alters a legal obligation or relationship, and therefore does not transform a particular article to a different state or thing. "Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances and they are not representative of physical objects or substances." *Bilski*, 545 F.3d at 963.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Anonymous, *Call Center Will Help Firms Retain Customer*, Origination News, New York: Nov. 1999.
- Rhonda L. Lipshutz, *Giving Those Tired Old Sites a New Look Companies are doing more with Their Websites in a Bid to Head Off Customer Defections*, Mortgage Technology, New York: May 2000.

- *Bank United Partners with Customers Forever to Offer Online Mortgages and Mortgage Statements to Customer*, PR Newswire, New York: May 2000.
- *GHR Systems Provides Key Component of Customers Forever Solution; PremierWare Facilities Customers Forever's Focus on Retention*, PR Newswire, New York: Jan. 2000.
- *Customers Forever Takes Internet Loan 'Manufacturing' to Point-of-Sale For Mortgage Lenders*, PR Newswire, New York: Nov. 2000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED W. NEWTON whose telephone number is (571)272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/J. W. N./
for Jared Newton, Examiner of Art Unit 3693